

Remarks

Claims 1-8 are pending in this application, and stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,734,566 to Stengl ("Stengl") in view of U.S. Patent 4,733,359 to Luperti et al. ("Luperti").

I. Rejections Under 35 U.S.C. § 103

Claims 1-8 stand rejected as unpatentable over Stengl in view of Luperti.

Applicant respectfully submits that elements recited in independent claim 1 are not disclosed or suggested by either of the asserted references.

As discussed in prior office action responses, the feeder system of claim 1 is directed to a feeder having a "supervisory control means" that monitors for two events and continues feeding until at least one of the two events is detected.

The first of the two events is "encountering a divider indicator." The Examiner correctly relies on the Stengl reference as describing a feeder using a divider indicator. However, for the claim elements relating to the "second event" the asserted Luperti and Stengl references fail to disclose those elements. In particular, claim 1 recites the "supervisory control means . . . programmed to compare the number of enclosures actually fed for a collation to the expected number of respective corresponding specific enclosures". Thereafter the "second event" for stopping occurs when "the number of enclosures is equal to the expected number of enclosures".

Luperti describes two features relating to detecting errors in feed counts. For the first feature, a camera takes an image of a page count positioned on one of the

document pages. The image is displayed for viewing by the operator. Simultaneously, a counter displaying the number of fed sheets is also displayed for the operator. If there is a mismatch between the displayed count and the image, then the operator is provided with a switch toggle feeding on/off. See col. 3, line 13, to col. 4, line 15; col. 5, line 44, to col. 6, line 17.

This first feature, relating to operator image viewing of Luperti, fails to disclose or suggest the missing elements of claim 1 as recited above.

The second feature of Luperti is the use of a predetermined overcount to halt feeding. The predetermined overcount is described as being a quantity of fed sheets equal to the maximum number sheets that can be stuffed in an envelope. Examples, given in Luperti are 70 or 100 sheets. Thus, rather than being "programmed to compare the number of enclosures actually fed for a collation to the expected number of respective corresponding specific enclosures," Luperti describes comparison to an upper limit that is the same for all mail pieces, regardless of how many sheets should be in the set of enclosures. Luperti merely describes a gross upper-limit determined only by the physical stuffing limitations of the machine. See col. 6, lines 18-36; col. 7, lines 1-40.

Accordingly, this second overcount feature of Luperti fails to satisfy the missing claim language of independent claim 1 relating to the claimed "second event".

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385,

148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *in re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *in re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, supra; *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *in re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Because the asserted references do not disclose elements relating to the "second event" as recited in independent claim 1 and its dependent claims 2-5, these rejections should be withdrawn.

V. Conclusion

All issues having been addressed, Applicants submit that the present application is in condition for allowance.

Respectfully submitted,



Michael J. Cummings
Reg. No. 46,650
Attorney of Record
Telephone (203) 924-3934

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000